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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,875	03/01/2002	Michihiro Shibata	628653/0004	7195

7590

05/07/2003

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EXAMINER
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BLACKWELL RUDASIL, GWENDOLYN A

ART UNIT	PAPER NUMBER
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1775

3

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

mk-3

<b>Office Action Summary</b>	<b>Application No.</b> 10/087,875	<b>Applicant(s)</b> SHIBATA, MICHIIRO	
	<b>Examiner</b> Gwendolyn A. Blackwell-Rudasill	<b>Art Unit</b> 1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless –*

*(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.*

*(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.*

2. Claims 1-6 are rejected under 35 U.S.C. 102(a) as being anticipated by United States Patent no. 6,246,656, Kawakubo et al.

Kawakubo et al disclose, as illustrated in Figure 4, an optical recording medium composed of a substrate with a reflective layer formed on the substrate with an organic dye recording layer formed on the reflective layer. The substrate can be made of a light transmissive resin such as a polycarbonate with the reflective film made of Al or an Al alloy, Ti, Cr, or Au having a thickness of 20-60 nm, meeting the requirements of claims 1-4. In addition, the organic dye recording layer can be formed from materials such as cyanine, phthalocyanogen, diphthalocyanogen, anthracene, and materials forming them. On the organic dye recording layer a light transmissive layer made of an UV curing resin is placed, meeting the requirements of claims 5-6, (column 7, lines 26-65).

3. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by United States Patent Application Publication no. 2002/0034155, Usami.

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The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Usami discloses an optical information recording medium that is formed by having a substrate with a reflective layer formed thereon, a dye containing recording layer formed on the reflective layer, and a photocured layer formed on the recording layer, meeting the requirements of claim 1, (page 2, section 0014). Materials that can be used for the substrate are polycarbonates, acrylic resins, vinyl chloride resins, vinyl chloride copolymers, epoxy resins, amorphous polyolefin, glass, and polyester either alone or in combination, meeting the requirements of claim 2. In addition the dye used in the recording layer can be cyanine dyes, phthalocyanine dyes, oxonol dyes, metallic complex dyes, meeting the requirements of claims 5-6, (page 3, sections 0033 and 0035). See also page 6, sections 0054.

Usami also discloses that the reflective layer can be made from metals such as Cr, Ni, Pt, Cu, Ag, Au, Al, and stainless steel having a thickness generally ranging from 10-800 nm, meeting the requirements of claims 3-4. The protective layer has a thickness of 0.1-100  $\mu\text{m}$ , meeting the requirements of claim 7, (page 4, sections 0039-0040).

Usami et al also disclose an adhesive layer formed between the protective layer and the recording layer, wherein the adhesive layer is formed of a photocurable resin having a thickness of 0.1-100  $\mu\text{m}$ . The photocurable resin is selected in accordance with the main absorption band

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of the recording layer, meeting the requirements of claims 8, 13, and 15-19 (page 6, sections 0056-0058). As such, the same photocurable resins and additives that are used in the recording layer can also be used as the adhesive layer, meeting the requirements of claims 9-12, (page 6, section 0057 and page 3, sections 0035-0037). When an adhesive layer is used, the protective film has a thickness ranging from 10-300  $\mu\text{m}$ , meeting the requirement of claim 20, (page 6, sections 0056).

Usami et al further disclose an intermediate layer formed between the recording layer and the adhesive layer, wherein silicon oxide, silicon dioxide, magnesium fluoride, tin oxide, silicon nitride, and the like are materials used for the intermediate layer, meeting the requirements of claim 14, (page 6, section 0055).

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

United States Patent nos. 5,998,094 and 6,309,728 disclose the materials of the reflective layer, recording layer, and protective layer.

United States Patent no. 5,236,755, disclose the recording medium structure as set forth by applicant.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gwendolyn A. Blackwell-Rudasill whose telephone number is

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(703) 305-9741. The examiner can normally be reached on Monday - Thursday; 6:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (703) 308-3822. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Gwendolyn A. Blackwell-Rudasill  
Examiner  
Art Unit 1775

gbr  
April 30, 2003

  
DEBORAH JONES  
SUPERVISORY PATENT EXAMINER